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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,297	02/07/2001	Andrew S. Van Luchene	97-564X	7186

7590

07/08/2004

DEANALDERUCCI  
Walker Digital Corporation  
Five High Ridge Park  
Stamford, CT 06905

EXAMINER


DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/777,297	Applicant(s) VAN LUCHENE, ANDREW S.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/02, 4/30/03</u> . | 6) <input type="checkbox"/> Other: _____  |

IDS -> 4/30/03, 3/28/02, 3/29/02, 2/7/01

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### DETAILED ACTION

1. Claims 1-18 have been examined.

#### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 1-18 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-18 of prior U.S. Patent No. 6,223,163. This is a double patenting rejection.

#### *Priority*

3. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 1.78. Applicant is not granted priority to either stated CIP

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patents Walker (6,267,670) or Walker (6,119,099). Neither of these patents provide support for the Applicant's claim independent claim 1. Neither patent supports the features of tracking performance of upsells or rates of performance of upsells as disclosed in claim 1 of the present application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (6,055,513) in view of Barnett (6,321,208).

Katz discloses providing a plurality of upsells at a POS terminal (Abstract; col 7, lines 25-35; col 5, line 60-col 6, line 7).

Katz does not explicitly disclose measuring a performance rate of the upsell.

However, Barnett discloses measuring a performance rate of each offer, selecting a subset of offers based on at least one of the plurality of performance rates; and providing the subset of offers at the POS terminal (col 12, line 25-col 13, line 10; Fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's offers based on performance rates to Katz's upsells

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offered to the customer. One would have been motivated to do this in order to provide offers that will likely be of more interest to the user.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Gerace (5,848,396) discloses providing offers based on performance rates of offers.

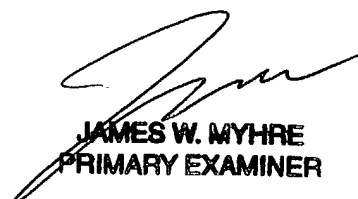
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

6/17/04

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**

METHOD AND APPARATUS FOR CONTROLLING OFFERS THAT ARE  
PROVIDED AT A POINT-OF-SALE TERMINAL

**COPY**

The present application is a continuation-in-part application of co-pending Patent  
5 Application No. 08/920,116, entitled METHOD AND SYSTEM FOR PROCESSING  
SUPPLEMENTARY PRODUCT SALES AT A POINT-OF-SALE TERMINAL, filed on  
August 26, 1997, which is a continuation-in-part of co-pending Patent Application No.  
08/822,709, entitled SYSTEM AND METHOD FOR PERFORMING LOTTERY TICKET  
TRANSACTIONS UTILIZING POINT-OF-SALE TERMINALS, filed on March 21, 1997, each  
10 of which are incorporated herein by reference.

31046 U.S. PTO  
09/777297  
02/07/01

CROSS REFERENCE TO CO-PENDING APPLICATIONS

The present invention is related to the following United States Patent Applications filed  
contemporaneously herewith:

- 15 U.S. Patent Application Ser. No. 09/045,326, entitled METHOD AND APPARATUS  
FOR FACILITATING THE PLAY OF FRACTIONAL LOTTERY TICKETS UTILIZING  
POINT-OF-SALE TERMINALS (Attorney Docket No. WD2-97-558), U.S. Patent Application  
Ser. No. 09/045,412, entitled METHOD AND APPARATUS FOR PROCESSING A  
SUPPLEMENTARY PRODUCT AT A POINT-OF-SALE TERMINAL (Attorney Docket No.  
20 WD2-97-561), U.S. Patent Application Ser. No. 09/045,326, entitled METHOD AND  
APPARATUS FOR CONTROLLING THE PERFORMANCE OF A SUPPLEMENTARY  
PROCESS AT A POINT-OF-SALE TERMINAL (Attorney Docket No. WD2-97-557), and U.S.  
Patent Application Ser. No. 09/045,344, entitled METHOD AND APPARATUS FOR